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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,881

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Hiroe Suzuki

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EXAMINER

ZELANO, JOHN A

ART UNIT

PAPER NUMBER

4156

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,881	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> JOHN ZELANO	<b>Art Unit</b> 4156	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/14/2005</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

As required by MPEP § 2181(I), system claims 1, 11, and 12 are being treated under 35 U.S.C. 112, 6th paragraph.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

In order for a method to be considered a “process” under 35 U.S.C. 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101 and is nonstatutory subject matter.

Claims 4-6 and 13 do not recite a substantive tie of the method to another statutory class in the body of the claim. As such, these claims are rejected as non-statutory.

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which

Art Unit: 4156

constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” *The New IEEE Standard Dictionary of Electrical and Electronics Terms* 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

System claims 1-3 and 11-12 recite a system without reference to another statutory class in the body of the claim. As such, these claims seem drawn to software elements; thereby the claims are directed to software per se. As such, these claims are rejected as non-statutory.

Claims 7-10 and 14 fail to recite in the preamble a computer program that is embodied on a computer-readable medium. The claim is merely directed to a

Art Unit: 4156

computer program per se. Proper format should resemble the following: "A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform the steps of". As such, these claims are rejected as non-statutory.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 2, 4-5, 7-8, 10-11, and 13-14 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yoko Ishino in view of her patent,**

**Device and Method for Forming a Product Concept (JP 2001056763,  
hereinafter referred to as Ishino).**

**As to claim 1**, Ishino teaches a brand-creation process evaluation system (Detailed description, paragraphs 70-73), comprising: model format storing means (Detailed description, paragraph 73);

that stores information on a model format representing a cyclic process of brand knowledge creation (Drawing 1);

in which arrangement of dynamic evaluation parameters (Detailed description, paragraphs 134-136; N-tuple based parameters for model setup);

which correspond to groups of indices obtained by factor analysis of several indices for dynamic evaluation of a brand, respectively, is set (Detailed description, paragraphs 126-136; Here factors derived from the questionnaires are input into different model types for iterative calculation);

object brand parameter acquiring means that acquires dynamic evaluation parameters for a target brand to be evaluated (Detailed description, paragraphs 42, 48-50);

model creating means that creates a brand-creation process evaluation model of the target brand by arranging the dynamic evaluation parameters for the target brand (Detailed description, paragraphs 42-44; Top-down strategic rules enable modeling of current or competitive brands);

which are acquired by the target brand parameter acquiring means, in positions set in the model format with reference to information of the model format (Drawing 1; Detailed description, paragraphs 42-44, 70-73, 126-127);

and output means that outputs information on the brand-creation process evaluation model created by the model creating means (Detailed description, paragraph 29).

**As to claim 2**, see the discussion of claim 1. Ishino further discloses the limitation wherein the dynamic evaluation parameters include a contact parameter representing the degree of "contact" with a brand (Ishino, detailed description, paragraph 20; Brand idea);

a cognition parameter representing the degree of "cognition" being tacit knowledge with respect to the brand (Ishino, detailed description, paragraph 50; Brand knowledge);

an interaction parameter representing the degree of "interaction" being explicit knowledge with respect to the brand, (Ishino, detailed description, paragraph 15; Brand association);

and a coherence parameter representing the degree of "coherence" being another tacit knowledge with respect to the brand, (Ishino, detailed description, paragraph 16; Brand attributes);

and arrangement of these parameters is set on a circulation path in the order described above in the model format (Ishino, detailed description, paragraphs 45-50 and 126-139; Brand modeling, bottom-up strategy).

**As to claim 4**, this method claim repeats the subject matter of system claim 1 in a series of analogous steps. See the discussion of claim 1 above. As the underlying processes have been shown to be fully disclosed by the teachings of Ishino in the above rejection of claim 1, it is readily apparent that her teachings

Art Unit: 4156

perform the recited methods outlined in claim 4. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and are incorporated herein.

**As to claim 5**, this method claim repeats the subject matter of system claim 2 in a series of analogous steps. See the discussion of claims 2 and 4 above. As the underlying processes have been shown to be fully disclosed by the teachings of Ishino in the above rejection of claim 2, it is readily apparent that her teachings perform the recited methods outlined in claim 5. As such, these limitations are rejected for the same reasons provided in the rejection of claim 2 and are incorporated herein.

**As to claim 7**, this claim repeats the subject matter of system claim 1 for program code executing on a computer system. See the discussion of claim 1 above. Ishino discloses the invention substantially as claimed including the execution of program code on a computer readable medium (Detailed description, paragraphs 27-28, and 30-31). As the underlying processes have been shown to be fully disclosed by the teachings of Ishino in the above rejection of claim 1, it is readily apparent that her teachings perform the recited functions as outlined in claim 7. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and are incorporated herein.

**As to claim 8**, see the discussion of claim 7. This claim repeats the subject matter of system claim 2 for program code to be embedded on a computer-readable medium. See the discussion of claim 2 above. Ishino discloses the invention substantially as claimed including the execution of



Art Unit: 4156

program code on a computer readable medium (Detailed description, paragraphs 27-28, and 30-31). As the underlying processes have been shown to be fully disclosed by the teachings of Ishino in the above rejection of claim 2, it is readily apparent that her teachings perform the recited functions as outlined in claim 8. As such, these limitations are rejected for the same reasons provided in the rejection of claim 2 and are incorporated herein.

**As to claim 10**, see the discussion of claim 7. This claim repeats the subject matter of claim 1 for program code to be embedded on a computer-readable medium. See the discussion of claim 1 above. Ishino discloses the invention substantially as claimed including the execution of program code on a computer readable medium (Detailed description, paragraphs 27-28, and 30-31). As the underlying processes have been shown to be fully disclosed by the teachings of Ishino in the above rejection of claims 1 and 7, it is readily apparent that her teachings perform the recited functions as outlined in claim 10. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1 and 7 and are incorporated herein.

**System claim 11** repeats the subject matter of claims 1 and 2 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Ishino in the above rejections of claims 1 and 2, it is readily apparent that the Ishino reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1 and 2 and are incorporated herein.

Art Unit: 4156

**As to claim 13**, this method claim repeats the subject matter of claims 1 and 2 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Ishino in the above rejections of claims 1 and 2, it is readily apparent that the Ishino reference includes a method to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1 and 2 and are incorporated herein.

**As to claim 14**, this method claim repeats the subject matter of claims 1 and 2 as a set of “means-plus-function” elements rather than a series of steps for program code executing on a computer system. Ishino discloses the invention substantially as claimed including the execution of program code on a computer readable medium (Detailed description, paragraphs 27-28, and 30-31). As the underlying process has been shown to be fully disclosed by the teachings of Ishino in the above rejections of claims 1 and 2, it is readily apparent that the Ishino reference includes a method to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claims 1 and 2 and are incorporated herein.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the

invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 3, 6, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishino in view of Fiona Harris and Leslie de Chernatony, Corporate Branding and Corporate Brand Performance (PTO-892, hereinafter referred to as Harris).**

**As to claim 3**, Ishino teaches a brand-creation process evaluation system according to claim 2, (Ishino, paragraphs 70-74);

wherein the dynamic evaluation parameters further include a characterization parameter representing "characterization", (Ishino, detailed description, paragraph 15; Brand Identity) which serves as an opportunity for shift from "contact" (Brand idea, detailed description, paragraph 20 and 50) with a brand to "cognition" (Brand Knowledge, detailed description, paragraph 50) of the brand;

Ishino does not specifically teach an alignment parameter that appears when "interaction" of the brand shifts to "coherence". Harris specifically teaches a generalized gap model to represent brand identity which includes an alignment parameter representing "alignment" (Harris, Figure 1; page 446, second paragraph; Here corporate branding is discussed but alignment must still occur for customers, employees, and stakeholders to achieve coherency with the brand's identity) that appears when "interaction" of the brand shifts to "coherence",

and the model format sets arrangement of the characterization parameter in association with a path from the contact parameter to the cognition parameter and sets arrangement of the alignment parameter in association with a path from the interaction parameter to the coherence parameter (Harris, Figure 1; pages 442-446).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ishino to have included the features as taught by Harris because those in the art would have recognized applying the known techniques of Harris would have yielded an improvement and were

Art Unit: 4156

predictable. For example, applying the known techniques of Harris would improve the system of Ishino by making a more detailed model of brand evaluation which can dynamically evaluate brand equity and identity throughout the product life cycle.

**As to claim 6**, see the discussion of claim 5. This method claim repeats the subject matter of system claim 3 in a series of analogous steps. See the discussion of claim 3 above. As the underlying processes have been shown to be fully disclosed by the teachings of Ishino and Harris in the above rejection of claim 3, it is readily apparent that their teachings perform the recited methods outlined in claim 6. As such, these limitations are rejected for the same reasons provided in the rejection of claim 3 and are incorporated herein.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ishino to have included the features as taught by Harris because those in the art would have recognized applying the known techniques of Harris would have yielded an improvement and were predictable. For example, applying the known techniques of Harris would improve the system of Ishino by making a more detailed model of brand evaluation which can dynamically evaluate brand equity and identity throughout the product life cycle.

**As to claim 9**, see the discussion of claim 8. This claim repeats the subject matter of system claim 3 for program code executing on a computer system. See the discussion of claim 3 above. Ishino in view of Harris, discloses the invention substantially as claimed including the execution of program code on

Art Unit: 4156

a computer readable medium (Detailed description, paragraphs 27-28, and 30-31). As the underlying processes have been shown to be fully disclosed by the teachings of Ishino and Harris in the above rejection of claim 3, it is readily apparent that their teachings perform the recited functions as outlined in claim 9. As such, these limitations are rejected for the same reasons provided in the rejection of claim 3 and are incorporated herein.

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ishino to have included the features as taught by Harris because those in the art would have recognized applying the known techniques of Harris would have yielded an improvement and were predictable. For example, applying the known techniques of Harris would improve the system of Ishino by making a more detailed model of brand evaluation which can dynamically evaluate brand equity and identity throughout the product life cycle.

**As to claim 12**, see the discussion of claim 11. This claim repeats the subject matter of claim 3 as a set of “means-plus-function” elements rather than a series of steps. See the discussion of claim 3 above. Ishino in view of Harris, discloses the invention substantially as claimed. As the underlying process has been shown to be fully disclosed by the teachings of Ishino and Harris in the above rejection of claim 3, it is readily apparent that their references when combined, include a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 3 and are incorporated herein.

Art Unit: 4156

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ishino to have included the features as taught by Harris because those in the art would have recognized applying the known techniques of Harris would have yielded an improvement and were predictable. For example, applying the known techniques of Harris would improve the system of Ishino by making a more detailed model of brand evaluation which can dynamically evaluate brand equity and identity throughout the product life cycle.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN ZELANO whose telephone number is (571) 270-7047. The examiner can normally be reached on Monday through Friday, 7:30AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4156

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN ZELANO/  
Examiner, Art Unit 4156  
11/18/2008

/Charles R. Kyle/  
Supervisory Patent Examiner, Art Unit 4156